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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,674	08/20/2003	Michael Black	MIB-103/US	8294
30869	7590	01/12/2005		
LUMEN INTELLECTUAL PROPERTY SERVICES, INC. 2345 YALE STREET, 2ND FLOOR PALO ALTO, CA 94306				
			EXAMINER O'CONNOR, CARY E	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,674

Applicant(s)

BLACK

Examiner

Cary E. O'Connor

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-21, 24-28 and 31-36 is/are rejected.
- 7) ☒ Claim(s) 4, 22, 23, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>82003</u> . | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "said toothpick" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 8, 11-15, 18-20, 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi (5,271,734). Takeuchi shows a device 26 for light treatment of a body structure (column 2, lines 28-29) comprising a handle 44, wherein the handle comprises a light source 52 capable of delivering a light beam, a slender and elongated element (an optical guide) 20 optically connected to the light source, wherein

the light beam radiates through the surface of the element and is not limited to radiation through the tip of the element (column 3, lines 13-35). As to claim 5, note that the figures show the element as being tapered. As to claim 8, note that the surface of the element includes texture 30. As to claims 11 and 26, the handle is removable from the element, as shown in Fig. 1 (see also, column 2, lines 40-47). As to claim 12, note that the element may be made of a soft, transparent plastic (column 2, lines 5-6). As to claims 13, 24 and 27, note that the element may be made of an elastic material, inherently making it bendable (column 2, lines 9-10). As to claims 14 and 28, note that the figures show the element at a pre-arranged angle. As to claim 15, note that the light source may be a low power laser (column 2, lines 22-29). As to claim 25, Takeuchi discloses that the light source may be a soft laser whereby the device may be used to treat parts of the mouth.

Claims 1, 2, 9, 10, 15-21, 25, 28, 31, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Altshuler (6,304,712). Altshuler shows a device for light treatment of a body structure comprising a handle 1, wherein the handle comprises a light source 3 capable of delivering a light beam, a slender and elongated element 7 optically connected to the light source, wherein the light beam radiates through the surface of the element and is not limited to radiation through the tip of the element. As to claims 2 and 10, note that the element is transparent (column 2, line 44). As to claim 9, note that the element comprises bristles. As to claim 15, note that the light source may comprise a semiconductor laser (last paragraph of column 3). As to claims 16 and 31, note column 1, line 64 through column 2, line 33. As to claim 17,

note column 2, lines 7-11. As to claim 20, note column 1, lines 59-61. As to claims 21, 33 and 34, note that the body structure may be massaged in combination with the treatment (column 2, line 25).

Claims 1, 3, 5, 6, 12-14, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Brattesani (5,423,677). Brattesani shows a device comprising a handle 22, wherein the handle comprises a light source capable of delivering a light beam (column 4, lines 50-63), a slender and elongated element (optical guide) 10 optically connected to the light source, wherein the light beam radiates through the surface of the element and is not limited to radiation through the tip of the element (column 5, lines 25-28). As to claim 5, note that the figures show the element as being tapered. As to claim 6, note that the element comprises a bead shaped 28. As to claims 12 and 13, note column 6, lines 2-7. As to claim 14, note that the figures show the element at a pre-arranged angle. As to the recitation that the device is for light treatment, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 1-3, 6-8, 13, 17-20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (6,304,712). Davis shows a device comprising a handle 26,

wherein the handle comprises a light source 28 capable of delivering a light beam, a slender and elongated element 12 optically connected to the light source, wherein the light beam radiates through the surface of the element and is not limited to radiation through the tip of the element. As to claim 2, note column 4, lines 56-59. As to claim 6, note that the element may comprise a bead shape 34a. As to claim 7, note that the element may comprise a flat shaped head 34b. As to claim 8, the surface of the element may comprise a texture 30. As to claim 13, note that the element is bendable and formable (column 3, lines 66-67). As to the recitation that the device is for light treatment, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi (5,271,734) in view of Myers (6,019,605). Takeuchi teaches that the light source may be a soft laser whereby the device may be used to treat parts of the mouth. Takeuchi does not teach the step of adding an agent to the body structure. Myers teaches a method of treating a periodontal pocket with a laser wherein an agent (pigment) is added to the pocket to enhance the laser energy. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a pigment to the pocket in the procedure of Takeuchi, as taught by Myers, in order to enhance the laser energy to make the procedure more effective.

Allowable Subject Matter

Claims 4, 22, 23, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 35 and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Drawings

The drawings are objected to because two figures are labeled "Fig. 11" and there is no Fig. 13.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 1334 (Fig. 11).

Corrected drawing sheets, and/or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cary E. O'Connor
Primary Examiner
Art Unit 3732

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